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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,969	03/31/2004	Sergey M. Shevchenko	7759	8693
49459	7590	03/15/2006		
NALCO COMPANY 1601 W. DIEHL ROAD NAPERVILLE, IL 60563-1198			EXAMINER WU, IVES J	
			ART UNIT 1713	PAPER NUMBER

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/814,969

Applicant(s)

SHEVCHENKO ET AL.

Examiner

Ives Wu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-19 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 15 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

(1). Applicant's Remarks and Amendments filed on December 30, 2005 has been received and acknowledged.

Claims 1 ~13 are withdrawn. Claim 19 is newly added.

Claim 18 is amended. The 112 2nd rejection of claim 18 in the prior Office Action dated June 24, 2005 is withdrawn accordingly.

Claims 15 and 19 are allowable.

The rejections for claims 14,16 and 17 in the prior Office Action dated June 24, 2005 are sustained and presented together with the rejections for claim 18 in the following paragraphs.

Claim Rejections - 35 USC § 102

(2). The text of those sections of Title 35, U.S. Code not included in this Office Action can be found in the prior Office Action dated June 24, 2005.

(3). **Claims 14, 16** are rejected under 35 U.S.C. 102(b) as being anticipated by Baehr et al (US004880566) for the same rationale recited on page 4-6 in the prior Office Action dated June 24, 2005.

Claim Rejections - 35 USC § 103

(4). The text of those sections of Title 35, U. S. Code not include in this Office Action can be found in the prior Office Action dated June 24, 2005.

(5). **Claim 17** is rejected under 35 U.S.C. 103(a) as being unpatentable over Baehr et al (US004880566) in view of Christiansen (US004614646) for the same rationale recited on page 6-7 in the prior Office Action dated June 24, 2005.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baehr et al (US004880566).

As to the weight% of inert compounds in **dependent claim 18**, in the absence of showing criticality of the records, the optimization value of inert compounds content in a known process renders *prima facie obviousness* within one ordinary skill in the art. *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980).

Allowable Subject Matter

Claims 15 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed on December 30, 2005 have been fully considered but they are not persuasive. Applicants argue that prior art reference of Baehr et al simply does not teach or anywhere disclose DTMPA as a component in any of the stabilizer mixtures taught. In view of the recitation of Baehr et al at column 2, line 44-51): *that particularly suitable polyamine and/or amine polyphosphonic acids, if desired in the form of their alkali metal and/or ammonium salts, are diethylenetriamine penta-(methylenephosphonic acid) (DTPMP)* which is exactly same chemical structure as diethylenetriaminepentakis(methyl)phosphonic acid (DTMPA), moreover, it is disclosed in the Baehr's et al stabilizer mixture in the presence of polyacrylic acids (Abstract). As to the issue of synergistic effect of the combination, the applicants are reminded that claims define what applicant's regard as their invention. Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). *In re Zleta*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

For the 103 combinations of Baehr et al with Christiansen, applicants present the similar argument recited in the preceding paragraph. The response in the preceding paragraph would apply herein.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ives Wu whose telephone number is 571-272-4245. The examiner can normally be reached on 8:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Ives Wu
Art Unit: 1713
Date: March 13, 2006



DAVID W. WU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700